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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/824,463

04/15/2004

Jean-Michel Challe

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7055 7590 07/31/2008
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EXAMINER

MOHANDESI, JILA M

ART UNIT

PAPER NUMBER

3728

NOTIFICATION DATE

DELIVERY MODE

07/31/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/824,463 | Applicant(s) CHALLE, JEAN-MICHEL | |
| | Examiner JILA M. MOHANDESI | Art Unit 3728 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE 05/16/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 19-27, 29-41, 44, 47 and 53-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 19-27, 29-41, 44, 47 and 53-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/16/2008 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 22-27, 29-39 and 53-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaino (US 4,447,967) in view of Bartels (US 4,232,458), Abel (US 3289,328) and Caplan (US 2,003,105). Zaino discloses an article of footwear

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comprising: an upper; a bottom assembly (Sole, see column 2, lines 23-28); the upper comprising a liner (fabric sock) assembled together and two tightening quarters arranged on medial and lateral sides of the upper, respectively, each of the tightening quarters being attached at a lower end to the upper in an area of the bottom assembly (bands 14), and each of the tightening quarters is provided at the upper end with lacing guides (eyelets 7); the inner layer adapted to enclose toes of a wearer and includes a sole, and extends rearwardly to an area behind a heel of the wearer. Zaino does not appear to disclose the liner having an outer protective covering layer positioned over said extensible, ventilated material and no seam extending upwardly from the bottom assembly at the rear end of the upper. Bartels teaches that it is desirable to make liners from a breathable fabric having two woven layers which is extremely difficult to delaminate, does not use adhesives for lamination and further, provides for optimum air permeability, i.e., breathability, has good body and due to its structure provides for the face layer, i.e., the outer layer, to have a cosmetic effect in particular, a ruggedness which makes the fabric highly suitable for use in footwear particularly athletic footwear. The breathable fabric comprising a woven first layer and a woven second layer, said first layer at spaced points both longitudinally and laterally of said fabric being interwoven with said second layer to provide discrete tie-in points of said first layer to said second layer, the spacing between the tie-in points being sufficiently close to provide that the layers are always in contact with each other over the whole area of the adjacent surfaces. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the upper of Zaino with an inner

layer and an outer protective mesh layer as taught by Bartels to have a cosmetic effect in particular, a ruggedness which makes the fabric highly suitable for use in footwear particularly athletic footwear. "[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill."

Each of Abel and Caplan disclose that it is desirable to make upper without a seam extending upwardly from the bottom assembly at the rear end of the upper. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the upper without a seam extending upwardly from the bottom assembly at the rear end of the upper as taught by either one of Abel or Caplan to make the upper more comfortable. "[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill."

With respect to claims 26 and 27, official notice is taken that it is old and conventional to provide an outer gusset in the heel area of a liner/upper adapted to receive heel stiffeners and foam to provide more comfort to the wearer. Since applicant did not challenge the limitation under Official Notice, the limitation under Official Notice is now taken as admitted prior art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the admitted prior art of record to provide a gusset in the heel area of the modified liner/upper of Zaino to

receive the heel stiffener and to also provide a foam within the gusset between the liner and the heel stiffener to make the footwear more comfortable for the wearer.

With respect to claims 29, 30 and 33, note in Figure 1, that on the medial side of the upper, there is no seam extending from the bottom assembly through said extensible, ventilated textile material of the upper.

With respect to claims 35-36 and 53-55, Official Notice is taken that it is old and conventional to fix a liner to an article of footwear to prevent the liner from being removed from the footwear. Since applicant did not challenge the limitation under Official Notice, the limitation under Official Notice is now taken as admitted prior art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the admitted prior art of record to fix a liner to an article of footwear to prevent the liner from being removed from the footwear.

With respect to claims 38-39, 57 and 60-64, it is well known to provide an inner sole beneath the upper and above the outer sole to provide more cushioning and comfort to the wearer or not to provide an inner sole so a firmer feeling. Since applicant did not challenge the limitation under Official Notice, the limitation under Official Notice is now taken as admitted prior art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the admitted prior art of record to provide an inner sole beneath the upper and above the outer sole to provide more cushioning and comfort to the wearer or not to provide an inner sole so a firmer feeling.

Allowable Subject Matter

5. Claims 1-15, 19-21, 40-41, 44 and 47 are allowed.

Response to Arguments

6. Applicant's arguments with respect to claims 22-27 and 29-39 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JILA M. MOHANDESI whose telephone number is (571)272-4558. The examiner can normally be reached on MONDAY-FRIDAY 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey YU can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/JILA M MOHANDESI/
Primary Examiner, Art Unit 3728

JMM
July 28, 2008